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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,964	03/13/2001	Kazuhisa Kashihara	204702US2	8967

22850 7590 09/10/2003

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

PRASAD, CHANDRIKA

ART UNIT PAPER NUMBER

2839

DATE MAILED: 09/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AA

**Office Action Summary**

Application No.

09/803,964

Applicant(s)

KASHIHARA ET AL.

Examiner

Chandrika Prasad

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 March 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

1. The reply filed on 8/18/03 consists of amendments to all claims 1-4, changes in the drawing and specification and remarks related to rejection of claims. The claims are not allowable as explained below.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 3-4 are rejected under 35 U.S.C. 101 because these claims are directed to neither a "process" nor an "apparatus," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990), *Id.* at 1551.

Patents are not granted for all discoveries, but only for those, which are specifically provided for in 35 U.S.C. 101. This section requires that the invention be "new and useful" and **that it falls within one of the five specified classes of invention**, which are:

- a process or method (which may be a process of making something or a process of using something).
- a machine or apparatus
- a manufacture (article)
- a composition of matter

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- an improvement of any of the above

Claims 3 and 4 include two classes of invention, class 1 (a process or method) and class 2 (a machine or apparatus).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over common knowledge.

It would have been obvious to one having ordinary skill in the art at the time of the instant invention to use a mask and make a hole in the mask of the size of a metallic film to be formed on a planar lightwave circuit and form the metallic film because these manufacturing steps are common knowledge and would have been obvious to one of ordinary skill in a manufacturing process.

Furthermore, annealing is a well-known process in manufacturing. It would have been obvious to one having ordinary skill in the art at the time of the instant invention to use annealing before forming the metallic film because this would reduce the mechanical stresses in the circuit, which is well known.

6. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto.

Yamamoto (Claim 1) discloses a method of making a film on a planar substrate comprising the steps of making a mask with holes and manufacturing a film on the substrate through the hole and the use of annealing process. But Yamamoto does not show the film to be metallic. It would have been obvious to one having ordinary skill in the art at the time of the instant invention to make the film metallic because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use and metallic films are well known in the art. In re Leshin, 125 USPQ 416.

Furthermore, annealing is a well-known process in manufacturing. It would have been obvious to one having ordinary skill in the art at the time of the instant invention to use annealing before forming the metallic film because this would reduce the mechanical stresses in the circuit, which is well known.

7. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ohtani et al. and Yamazaki also teach a process of making a metallic film using a mask with a hole in it and an annealing process.

### ***Response to Arguments***

9. Applicant's arguments with respect to claims 1-4 have been considered but are moot in view of the new ground(s) of rejection.

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**Contact Information**

10. Any correspondence to this action may be mailed to:

**Commissioner for Patents  
Post Office Box 1450  
Alexandria, VA 22313-1450**

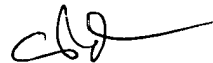
*Hand-delivered responses should be brought to:*

**Crystal Plaza 4, Fourth Floor (receptionist)  
2201 South Clark Place, Arlington, Virginia**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chandrika Prasad whose telephone number is (703) 308-0977.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynn Feild, can be reached at (703) 308-2710. The fax number for this Group is (703) 872-9318 (general) and (703) 872-9319 for after-final.

Any inquiry of a general nature or relating to the status of this application or processing should be directed to the Group receptionist whose telephone number is (703) 308-1782.



Chandrika Prasad  
Patent examiner  
August 28, 2003